

I. EFFECTIVE DATE OF VISHWANATH AS A REFERENCE

Vishwanath was published September 8, 2005, after Applicants' filing date of November 29, 2003. Vishwanath has a stated filing date of September 30, 2004, also after Applicants' filing date. However, Vishwanath is related to provisional application no. 60/510,721, which was filed on October 10, 2003. Thus, the earliest effective date of Vishwanath as a reference is October 10, 2003, under 35 U.S.C. § 102(e). Vishwanath is not citable as a statutory bar under 35 U.S.C. § 102(b) or any other subsection of § 102. The Office Action cites Vishwanath under 35 U.S.C. § 103(a).

II. APPLICANT IS ENTITLED TO A DATE OF INVENTION EARLIER THAN OCTOBER 10, 2003

When any claim of an application or a patent under reexamination is rejected, the inventor(s) of the subject matter of the rejected claim may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. 37 C.F.R. § 1.131. Upon proof of an earlier date of invention by Applicant, the Office is required to remove the reference. MPEP §715. An applicant can establish prior invention upon proof of conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice). MPEP §715.07(III)(c).

The Applicant is entitled to a date of invention earlier than October 10, 2003, because Applicants conceived of the invention long prior to October 10, 2003, and proceeded with diligence to a constructive reduction to practice of the invention, in the form of filing the U.S. patent application, on November 29, 2003. See Declaration of Douglass Wooff, Nobushige Akiya, and Matthew Balint, ("Applicants' Decl."), and Declaration of Kirk D. ("Wong Decl."),

submitted concurrently herewith. For purposes of this paper, the terms “Applicants” and “inventors” refer to the same individuals, Douglass Woeff, Nobushige Akiya, and Matthew Balint.

A. APPLICANTS CONCEIVED OF THE INVENTION PRIOR TO OCTOBER 10, 2003

The Applicants conceived of the invention prior to October 10, 2003. Applicants’ Decl., ¶3. The Applicants’ conception is established in Exhibits 1.1-1.4. Exhibits 1.1-1.4 constitute a complete and enabling disclosure of the claimed invention. Applicants’ Decl., ¶4.

Although the dates have been blocked out in the Exhibits, the Applicants aver that the true date of the Exhibits and conception is prior to October 10, 2003. Such an averment, supported by competent evidence as here, fulfills all requirements of the case law, rules and MPEP relating to proof of conception. Disclosure of the actual conception date is not required, because such a disclosure could seriously prejudice the Applicant in any later interference proceeding. See MPEP § 715.07(II).

B. APPLICANTS ACTED DILIGENTLY FROM BEFORE THE EFFECTIVE DATE OF THE REFERENCE UNTIL APPLICANTS’ FILING DATE

The Applicants acted diligently from before October 10, 2003 until the filing date of the application, as demonstrated by the Applicants’ declaration and the declaration of Kirk D. Wong, a patent attorney for the Applicants at the time of filing.

On October 24, 2003, the law firm of the attorney received disclosure materials from the inventor’s employer, Cisco Systems, Inc., which requested the attorney to begin preparing a patent application for the invention. Wong Decl. ¶2. A redacted copy of a database record indicating the date of the receipt of the disclosure materials is submitted as Wong Decl. Exhibit 2.1. The redacted copy omits information considered privileged or confidential and no waiver of privilege is intended.

On October 28, 2003 Mr. Wong sent an email to the inventors that requested a time to meet and discuss the invention. Wong Decl. ¶4. On October 29, 2003, due to scheduling conflicts, a disclosure meeting to discuss the invention for November 7, 2003 was scheduled. Wong Decl. ¶4. Communications for scheduling of the disclosure meeting are submitted as Wong Decl. Exhibit 2.3.

On November 7, 2003, the inventors and Mr. Wong held an invention disclosure meeting to discuss the invention. Wong Decl. ¶5.

On each of seven days spanning November 17, 2003 through November 25, 2003, Mr. Wong worked on preparing a draft of the patent application. Wong Decl. ¶6. On November 25, 2003, Mr. Wong finalized and filed the subject patent application in the USPTO. Wong Decl. ¶6.

On November 25, 2003, Mr. Wong sent a draft of the application to the inventor. Wong Decl. ¶7.

On November 26, 2003, inventors Nobushige Akiya and Matthew Balint sent emails to Mr. Wong that included comments about the draft of the application. Wong Decl. ¶8.

On November 28, 2003, a day before the application was filed in the USPTO, Mr. Wong emailed an updated draft of the application to the inventors. Wong Decl. ¶9.

Thus, individually and through their attorney, the Applicants acted diligently from the date of conception until a date just prior to the effective date of Vishwanath, as well as until the date of a constructive reduction to practice. While the constructive reduction to practice occurred after the effective date of Vishwanath, the date of conception was long prior to the effective date of Vishwanath. Therefore, under applicable law, Applicants are entitled to a date of invention earlier than Vishwanath.

III. CONCLUSIONS

The Declarations submitted herewith and the remarks herein establish that Applicants are entitled to a date of invention earlier than the effective date of Vishwanath. Therefore, Vishwanath is not citable as prior art against the application. Removal of Vishwanath as a reference, and further favorable consideration of the application, are respectfully requested.

If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,

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